

REMARKS

Applicants have carefully reviewed the Office Action mailed on May 10, 2011. Applicants respectfully traverse (and do not concede) all objections, rejections, adverse statements, and adverse assertions made by the Examiner. No claims are amended and no new matter is added. Claims 49, 50, 53-61, and 64-68 are presented for examination.

Withdrawal of Prior Art Rejections

Applicants respectfully note the current Office Action does not present a prior art rejection of the pending claims. As “[Patent] Office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code”, (*see e.g.*, MPEP § 2163(III)), Applicants understand the absence of a prior art rejection to indicate the Office has withdrawn all previous prior art rejections in view of Applicants previous correspondence in support of the patentability of the pending claims.

Claim Rejections Under 35 U.S.C. §112

Claims 49, 50, 53-61 and 64-68 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

Regarding independent claims 49, 60 and 68, the Office Action indicates that “there is no discussion of the thickness of the outer layer of the balloon in the specification” and that “[i]f applicant is relying upon the drawings (specifically elected Figure 2) to support this limitation, the examiner notes that, as no mention that the figures are drawn to scale is given, the drawings can not be relied upon to support [the limitations of these claims]” (emphasis added). Applicants respectfully disagree.

MPEP §2163 provides guidelines for the examination of applications under 35 U.S.C. §112, first paragraph. To satisfy the written description requirement, a patent application “must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention”. MPEP § 2163-1 (emphasis added). “An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as

words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.” *Id.* citing *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (emphasis added). Further, “the description of [an] article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art.” MPEP § 2125; *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977) (note, although MPEP § 2125 concerns prior art figures, the discussion is relevant for what figures are capable of teaching one having ordinary skill in the art). Moreover, the subject matter of the claims need not be described literally in order for the disclosure to comply with the description requirement. MPEP § 2163.02 (emphasis added).

In other words, the MPEP indicates that the written description requirement may be satisfied by the figures.

In this case, the claimed invention can be seen in the figures (e.g., FIG. 2). For example, claim 49 recites that the inner layer has a greater thickness in the body portion than in the proximal waist and that the outer layer has a lesser thickness in the body portion than in the proximal waist. These features are clearly seen in FIG. 2.

Regardless of whether or not the figures are drawn precisely to scale, the fact that relative differences in the thicknesses of various portions of the claimed balloons are seen in the drawings demonstrates to persons having ordinary skill in the art that Applicants had possession of the claimed invention at the time of filing the application. FIG. 2 shows the claimed features and it is clear error to indicate a person having ordinary skill would not reasonably recognize such features as being present from the face of FIG. 2 and particularly, when FIG. 2 is combined with the detailed description of the specification.

It also appears to be a clear error for the Office to continue to require that the specification indicate the figures are “drawn to scale” in order for Applicants to be able to utilize those figures to support claim amendments concerning relative sizes of features in the claims, as there is no such requirement in the MPEP or 37 C.F.R. This is particularly evident when the originally filed specification actually does discuss relative thicknesses of the outer layer compared to the inner layer and total thickness of the layers. For example, the specification at page 5, line 26 through page 6, line 7 provides examples of relative dimensions for layers 26/28 at different portions of the balloon. From this disclosure, it can

be appreciated that specification does disclose that the balloon may include layers having the structural features/configurations set forth in the claims. Indeed, balloon configurations can be readily gleaned from the specification including those that include the features recited in the claims. Therefore, not only do the figures provide support for the claimed invention, the specification also provides support sufficient to satisfy the written description requirement.

Based on these remarks, Applicants respectfully submit that the claimed features of “wherein the outer layer has a lesser thickness in the body portion than in the [proximal or distal] waist” are supported by the originally filed application in a manner that complies with the written description requirement. Accordingly, Applicants respectfully request that the rejections of claims 49, 60, and 68, as well as those claims depending therefrom, be reconsidered and withdrawn.

Conclusion


Further examination and withdrawal of the rejections is respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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